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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/008,363 | 11/07/2001 | Jamelyn D. Holladay | 13020G | 4377 |

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02/02/2006

Intellectual Property Services
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EXAMINER

COCKS, JOSIAH C

ART UNIT

PAPER NUMBER

3749

DATE MAILED: 02/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|---|-------------------------------|---------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/008,363 | Applicant(s) HOLLADAY ET AL. | |
| | Examiner Josiah Cocks | Art Unit 3749 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 January 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☒ Newly proposed or amended claim(s) See Continuation Sheet would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: See Continuation Sheet.


JOSIAH C. COCKS
PRIMARY EXAMINER

ADVISORY ACTION**Continuation of 3. NOTE:**

Applicant's amendment to claim 95 create a claim of a scope that was not previously considered by the examiner. As noted in the prior Office action, this claim was indefinite in referring to the "catalyst in the reformation chamber" without having introduced such a catalyst. The only claim in the application introducing such a catalyst was claim 18. As best could be determined by the examiner it appeared applicant intended to make claim 95 dependent upon claim 18 and was considered as such for the purpose of an examination on the merits. Applicant's amendment does not make claim 95 dependent upon claim 18, accordingly, claims 95, as now presented, is of a scope not previously considered by the examiner and would necessarily require further consideration and/or search. As amendments may not be entered piecemeal, the amendment to claim 98 has also not been entered.

Continuation of 6.

Newly proposed claim 98, as well as claims 1-9, 16-23, 63-80, 88-94, 96, 97, 99, and 100 previously indicated as allowable, would be allowable if submitted in a separate timely filed amendment cancelling the non-allowable claims.

Continuation of 11. does NOT place the application in condition for allowance because:

Applicant first argues that there is no motivation to combine the prior art references applied by the examiner primarily because the primary reference applied, WO 99/00186

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("186"), does not mention the formation of water in the exhaust channel. However, as noted in the prior Office action, the '186 patent clearly does disclose that water may form in the exhaust channel (note at least col. 10, lines 3-6 and col. 12, lines 29-35). The secondary reference, U.S. Patent No. 4876,162 to McElroy ("McElroy") has been applied to show a desirable arrangement of a wick to remove such water. Accordingly, applicant's argument is not persuasive.

Applicant then argues that when combined because the wick of McElroy in functioning to remove water from the reaction chamber includes portion of the wick that block passages (28 and 30) thereby preventing the escape of gas at a certain pressure when combined with the '186 patent the wick would block the channel of the '186 patent. The examiner does not agree. The examiner again notes that the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In this case, the function of the exhaust channel in the '186 patent is to provide for removal of gases both used in and produced by the microchannel device (e.g. note pages 11 and 12 of the '186 patent). Applicant's assertion that the wick must necessarily block these channels would obviate this function. Instead, the examiner considers that the combination of references would suggest maintaining the gas removal function of the '186 patent while incorporating the liquid evacuation system of McElroy to remove the water that is acknowledged (note discussion above) by the '186 patent to be present.

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Applicant also argues that the combination of references does not suggest a steam reformer as recited in claim 85. However, the '186 patent clearly does suggest the use of the disclosed device in a steam reformer (note at least the last paragraph of page 1 and the first paragraph of page 2).

Accordingly, applicant's arguments as to the allowability of claims 81-87 are not persuasive.

Continuation of 13. Other:

Applicant has asserted that the indication of Finality of the previous Office action is improper as the 35 USC 112 rejection applied to claims 95 and 98 was a new ground of rejection and these claims were not modified in applicant's prior response. However, the examiner notes that claim 95 and 98 were indicated to be dependent upon claim 85 which in turn was indicated to be dependent upon claim 84 which in turn indicated to be dependent upon claim 83. In the response filed 7/25/2005 applicant amended claim 83 to remove the term "evaporation" from the recitation of "liquid evaporation system" and substituted the term "evacuation". Applicant then proceeded to argue that the prior art did not suggest such a system for evacuating liquid from an exhaust channel (see response of 7/25/2005). This modification altered the scope of claim 83 and all its dependents. As required, the examiner further evaluated and considered the claims as then presented. As a result of this evaluation, the issues of indefiniteness that were applied to claims 95 and 98 were discovered. Accordingly, the application of the 35 USC 112 rejection to these claims was proper as well as the holding of Finality of the prior Office action.